

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

### REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

At the outset, Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why this amendment is necessary and was not presented earlier. This amendment is necessary to address new points made by the Examiner in the final rejection and, therefore, clearly is necessary. Further, since this is the first substantive response to the final rejection, this amendment could not have been presented earlier. In view of the foregoing, Applicants respectfully submit that a proper showing has been made and, accordingly, respectfully request that the Examiner enter and consider this amendment.

The sole issue for consideration is the rejection of claims 1-5 under 35 USC § 103(a) as being obvious over Hoffman, US 5,562,789, in view of Treleaven, US 6,413,345. In response, Applicants do not concede that the cited combination of references makes out a *prima facie* case of obviousness. However, Applicants believe that the Examiner may be persuaded to allow the application based on the unexpected results already of record. Consequently, Applicants place their emphasis in these remarks on such data.

In the first full paragraph on page 4 of the final rejection, the Examiner appears to concede that Applicants have demonstrated the surprising and, therefore, unexpected effect of increasing the speed with which the diecuts can be applied. However, the

Examiner expresses his belief that this demonstration is irrelevant as “applicant’s claims do not contain any limitations concerning the speed with which diecuts can be applied.”

In response to this point, Applicants would direct the Examiner’s attention to the decision in *In re Merchant*, 197 USPQ 785, 788 (CCPA 1978), for the proposition that a claim need not recite the improved properties of a product so long as the structural features which are responsible for the improved properties are recited in the claim. In the present case, the data demonstrate the improvement in diecut application speed that can be gained by using a non-straight line cut as opposed to a straight-line cut. The instant claims expressly require that the “diecutting line [be] a non-branching line having a form other than that of a straight line.” Accordingly, the feature that is responsible for the improvement in results, i.e., a diecutting line being a non-branching line having a form other than that of a straight line, is, in fact, recited in the instant claims. Following *Merchant*, the properties that flow from this claimed feature, i.e., the improved diecut application speed, are not only relevant, but must be considered.

For the Examiner’s convenience, Applicants repeat their arguments from the previous response concerning the demonstrated unexpected results. In this regard, Applicants would call the attention of the Examiner to the Example, which begins on page 23 of the specification. **The Examiner’s attention is especially directed to the discussion at page 25, lines 10-30.** Simply put, the requirement of the instant claims that the diecutting line is a non-branching line having a form other than that of a straight line is much more than a simple design choice. The use of the inventive form has the surprising effect of *increasing the speed* with which the diecuts can be applied. As taught at page 25, lines 10-12, straight-line diecuts can be dispensed from a device at a

maximum rate of *0.3 m/s*. In contrast, as taught at page 25, lines 13-15, a corresponding undular diecut can be dispensed from the same device at a much higher maximum rate of *2.0 m/s*. Speed of application is, of course, an important parameter in practice. Accordingly, the difference shown is of great practical effect. There is absolutely nothing in the combination of Hoffmann and Treleaven that teaches or suggests that use of an undular diecut form as opposed to a straight-line diecut form should increase the speed of application of the diecuts. Yet, this is exactly what the data in the instant specification prove happens. Further, the explanation at page 25, lines 16-30, provides a reasonable basis for concluding that the data are representative of the full breadth of the claims. Indeed, the specification teaches at page 25, lines 16-18, that “[t]he comparison shows that ‘non-straight’ cross-diecutting forms permit a faster application of the diecuts in contrast to a straight form of the diecutting line.” Again, the combination of Hoffmann and Treleaven is completely silent as to such a benefit. Accordingly, the data in the specification must be considered to be surprising, and, thus, unexpected, and, therefore, as objective evidence of the nonobviousness of the instant claims. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
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USSN 10/830,172

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Amendment under 37 CFR § 1.116 filed November 22, 2006